



**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Sadao FUJII et al.

Title: TRANSPARENT FILM  
Appl. No.: 09/869,864  
Filing Date: 08/28/2001  
Examiner: P. Hampton Hightower  
Art Unit: 1711

**SUBMISSION UNDER 37 C.F.R. § 1.114(c)**

**MAIL STOP RCE**

Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

The instant application has been withdrawn from issue for consideration of the concurrently filed Information Disclosure Statement citing references from a search report received in a corresponding PCT application.

In addition, Applicants note an error in the Remarks section of the Reply filed February 21, 2003. In the Remarks, it was stated that JP '240 did not qualify as § 102(b) art because the instant application had the benefit of priority of several Japanese applications. Under § 102(b), a reference qualifies as prior art if "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States." However, under § 363 the effective date of an international application designating the United States is the international filing date. JP '240 was published (March 21, 2000) less than a year before the international filing date of the present application (November 10, 2000). Thus, JP '240 does not qualify as prior art under 35 U.S.C. § 102(b).

**Conclusion**

In view of the above, applicants respectfully submit that all of the pending claims are in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is invited to contact the undersigned attorney at the local telephone number below.

Respectfully submitted,

Date August 13, 2003

FOLEY & LARDNER  
Customer Number: 22428



22428

PATENT TRADEMARK OFFICE

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By



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Registration No. 25,258

Martin S. Sulsky  
Registration No. 45,403

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.



Attorney Docket 089631-0112

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Sadao FUJII et al.  
Title: TRANSPARENT FILM  
Appl. No.: 09/869,864  
Filing Date: 08/28/2001  
Examiner: P. Hampton Hightower  
Art Unit: 1711

**INFORMATION DISCLOSURE STATEMENT**  
**UNDER 37 CFR §1.56**

**Mail Stop RCE**

Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Submitted herewith on Form PTO/SB/08 is a listing of documents known to Applicants in order to comply with Applicants' duty of disclosure pursuant to 37 CFR §1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR §1.97 and §1.98.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicants do not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a *prima facie* art reference against the claims of the present application.

**TIMING OF THE DISCLOSURE**

The listed documents are being submitted in compliance with 37 CFR §1.97(b)(4), before the mailing of a first Office action with the filing of a Request for Continued Examination under §1.114.

**RELEVANCE OF EACH DOCUMENT**

The foregoing documents came to Applicants' attention during a search of the corresponding Japanese application. A copy of the International Search Report setting forth the portion of each reference considered relevant by the examiner is attached.

English translations of the foreign-language documents are not readily available. However, the absence of such translations does not relieve the PTO from its duty to consider any submitted documents (37 CFR §1.98 and MPEP§609). English language abstracts are attached.

Applicants respectfully request that any listed document be considered by the Examiner and be made of record in the present application and that an initialed copy of Form PTO/SB/08 be returned in accordance with MPEP §609.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

Date: August 13, 2003

FOLEY & LARDNER  
Customer Number: 22428



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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449B/PTO <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> Date Submitted: August 13, 2003 (use as many sheets as necessary)		<b>Complete if Known</b>	
Application Number		09/869,864	
Filing Date		08/28/2001	
First Named Inventor		Sadoa FUJII	
Group Art Unit		1711	
Examiner Name		P. Hampton Hightower	
Attorney Docket Number		089631-0112	

U.S. PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code <sup>2</sup> (if known)			
	A1	4,246,374		KOPCHIK	01-20-1981	
	A2	4,374,951		LEE, DECEASED ET AL.	02-22-1983	
	A3	4,381,373		IKUMA	04-26-1983	
	A4	4,727,117		HALLDEN-ABBERTON ET AL.	02-23-1988	
	A5	5,536,798		DOI ET AL.	07-16-1996	
	A6	5,580,928		DOE ET AL.	12-03-1996	

FOREIGN PATENT DOCUMENTS								
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document			Name of Patentee or Applicant of Cited Documents	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Office <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)				
	A7	JP	02-153904		KYOWA GAS CHEM IND CO LTD	06-13-1990		A
	A8	JP	05-059131		TOSOH CORP	03-09-1993		A
	A9	JP	06-136058		TOSOH CORP	05-17-1994		A
	A10	JP	09-328523		TOSOH CORP	12-22-1997		A
	A11	JP	2000-080240		TOSOH CORP	03-21-2000		A

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>6</sup>

Examiner Signature		Date Considered	
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached Kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

<sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.